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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,292	12/12/2003	Geoffrey H. White	EDWA0018U-US	2518
31518	7590	08/23/2005	EXAMINER	
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tate

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/733,292	WHITE ET AL.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/25/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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The disclosure is objected to because of the following informalities: In claims 13-19, line 1, "1" should be "12". Appropriate correction is required.

The proposed new figure 8 filed July 6, 2005 will not be entered because it contains new matter. There is no basis in the original disclosure for the specific shape shown in figure 8. Specifically, 1) the lower left branch being curved while the lower right branch is not, 2) the specific angle between the branches and 3) the relative diameter of the branches as compared to the upper main trunk is new matter.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bifurcated prosthesis defined in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 12-16, 19, 20 and 25-36 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Piplani et al. (5,489,295). As to claims 12 and 20, Piplani et al., in figure 4, disclose prosthesis 20 wherein at least one of the first and second ends is provided with a wire structure (126 or 127) which has a plurality of apices (e.g. 132) extending beyond at least a portion of the corresponding end. The apices are inherently capable of being located across a lumen of a second vessel. For example, viewing figure 19, if the prosthesis 20 is inserted into a patient who has arteries (shown in figure 19 extending laterally near the top of the figure) which are closer to the

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aortic bifurcation 221 than the example shown in figure 19, than the apices 132 on wire structure 126 would be located across the lumen of each of the laterally extending arteries. Alternatively, it would have been obvious that the apices are capable of being located across a lumen of a second vessel for this reason. As to claims 25-30, wire structure (126 or 127) has a shape that is clearly generally sinusoidal or zig-zag even though it is not a perfect sine wave. As to claims 31-36, Piplani et al. disclose first and second wires (the lengths of platinum wires described in col. 5, lines 23-27).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piplani et al. (5,489,295) in view of Kornberg (4,617,932). Piplani et al. fail to disclose stainless steel or plastic as the material for the wire structure. However, it is old and well known to use these materials in order to obtain the advantage of making the device biocompatible as well as strong. For example, Kornberg teaches that such materials may be used for the wire structures 16 and (14, 15) in an aortic graft for these reasons (col. 4, lines 8-17, 25-29 and 48-49). It would have been obvious to use either of these materials for the Piplani et al. wire structures so that it too would have these advantages.

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Claims 21-36 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cragg (5,665,115). Cragg discloses a prosthesis (figures 7-9) wherein at least one of the first and second ends is provided with a wire structure 11 which has a plurality of apices extending beyond at least a portion of the corresponding end (in the embodiment in which the graft 13 is shorter than the wire helix as described in col. 3, lines 29-31), wherein the apices are formed from malleable material that it not substantially resilient (col. 4, lines 24-26). The apices are inherently capable of being located across a lumen of a second vessel. Alternatively, it would have been obvious that the apices are capable of being located across a lumen of a second vessel. As to claims 31-36, Cragg discloses first and second wires (the wire hoops of wire body 11 which are located near the middle of the prosthesis).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Although already of record, note col. 6, lines 38-42 of Barone (5,360,443) and Palmaz (4,733,665) which discloses wire member 71 in figures 1A and 1B.

Applicant's arguments filed July 6, 2005 have been fully considered but they are not persuasive for the reasons set forth above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht  
8/18/05



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731